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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,110	05/24/2001	William Alton Fiveash	AUS9-2000-0924-US1	1467

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EXAMINER

HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/864,110	Applicant(s) FIVEASH ET AL.	
	Examiner Matthew T Henning	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/16/2004</u>   | 6) <input type="checkbox"/> Other: _____                                    |

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This action is in response to the communication filed on 5/24/2001.

### **DETAILED ACTION**

1. Claims 1-20 have been examined.

#### ***Title***

2. The title of the invention is acceptable.

#### ***Priority***

3. No claim for priority has been made for this application.
4. The effective filing date for the subject matter defined in the pending claims in this application is 5/24/2001.

#### ***Information Disclosure Statement***

5. The information disclosure statement (IDS) submitted on 9/16/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

#### ***Drawings***

6. The drawings filed on 2/24/2001 are acceptable for examination proceedings.

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. Regarding claims 1, 8, and 14, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. One of ordinary skill in the art would be unable to determine whether the data exchanged over the communication path was required to include identification information and digital certification information or whether these were merely meant as examples of data that could be exchanged over the communication path, and would therefore be unable to determine the scope of the claims. Therefore, claims 1, 8, and 14 are rejected for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. See MPEP § 2173.05(d). For purposes of searching prior art, the examiner will assume the limitation was meant to read "creating a communication path to exchange identification data and digital certification data between the two systems".

10. Claims 2-7, 9-13, and 15-20 are rejected by virtue of their dependency to claims 1, 8, and 14.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

12. Claims 1-5, 7-12, 14-18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Elgamal et al. (US Patent Number 5,657,390) hereinafter referred to as Elgamal.

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13. Regarding claim 1, Elgamal disclosed a method of establishing a secure communication path between two computer systems (See Elgamal Col. 3 Paragraph 3) comprising: creating a communication path to exchange data (See Elgamal Col. 6 Line 57 – Col. 7 Line 12) such as identification data and digital certification data between the two systems (See Elgamal Fig. 4 and Col. 7 Lines 13-40 and Fig. 5 and Col. 8 Line 45 – Col. 10 Line 23); determining, based on the identification data, whether to confirm the digital certification data (See Elgamal Figs. 4-5, Col. 7 Lines 20-65, Col. 10 Lines 3-23, Col. 20 Lines 25-32, Col. 22 Line 56 – Col. 23 Line 18); and creating a secure communication path, without confirming the digital certification data if it is determined the digital certification data should not be confirmed (See Elgamal Fig. 5 and corresponding text) , or after confirming the digital certification data if it is determined that the digital certification data should be confirmed (See Elgamal Fig. 4 and Corresponding text).
14. Regarding claim 2, Elgamal disclosed that the determining step includes the step of consulting an internal table, the internal table including identification data of all computer systems whose digital certification need not be confirmed (See Elgamal Col. 8 Lines 45-61 and Col. 10 Lines 3-23).
15. Regarding claim 3, Elgamal disclosed he two computer systems include a local and a remote computer system, the exchanged data further including one or more authentication proposals from the local computer system and a selected authentication proposal from the remote system (See Elgamal Col. 5 Paragraph 3 and Col. 10 Lines 3-23).
16. Regarding claim 4, Elgamal disclosed selecting an access method in response to determining to confirm the digital certification data; and invoking the selected access method (See Elgamal Col. 7 Lines 13-40).

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17. Regarding claim 5, Elgamal disclosed selecting a local-remote pair from an endpoints table corresponding to the computer systems (See Elgamal Col. 8 Line 45 – Col. 9 Line 31); selecting a policy from a policy table based on the selected local-remote pair, the policy including one or more access methods (See Elgamal Col. 9 Lines 9-14); and transmitting one or more security proposals corresponding to the selected policy to the remote computer system (See Elgamal Col. 10 Lines 3-6).

18. Regarding claim 7, Elgamal disclosed digitally signing a message using a private key corresponding to one of the computer systems; and sending the signed message to the other computer system (See Elgamal Figs. 4 and 5 and Col. 8 Lines 5-20).

19. Claim 8 is rejected for the same reasons as claim 1 above and further because Elgamal disclosed an information handling system comprising: one or more processors; a memory accessible by the processors; a nonvolatile storage accessible by the processors; a network interface connecting the information handling system to a computer network (See Elgamal Col. 3 Lines 46-55); and a network security tool to create a secure path between computer systems (See the rejection of claim 1 above).

20. Claims 9-12 are rejected for the same reasons as claims 2-5 above as applied to claim 9 above.

21. Claim 14 is rejected for the same reasons as claim 1 above and further because Elgamal disclosed a computer program product for implementing the SSL System (See Elgamal Abstract and Claims).

22. Claims 15-18 are rejected for the same reasons as claims 2-5 above as applied to claim 14 above.

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23. Claims 20 is rejected for the same reasons as claim 7 above as applied to claim 14 above.

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

25. Claims 6, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elgamal as applied to claims 1, 8, and 14 above, and further in view of Schneier (Applied Cryptography).

Elgamal disclosed receiving a remote digital certificate from the other computer system (See Elgamal Col. 7 Lines 20-26), but Elgamal failed to disclose verifying the certification authority signature on the certificate. However, Elgamal did disclose issuing a “bad certificate” error if the signature on the certificate was bad (See Elgamal Col. 20 Lines 25-33).

Schneier teaches that certification authorities sign certificates, and that in order to verify whether a certificate is bad or not, the signature of the certification authority on the certificate must be verified (See Schneier Pages 185 – 186 Section Entitled “Public-key Certificates”, Especially page 186 Lines 1-8).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Schneier in the certificate authentication of Elgamal by checking to make sure the signature on the certificate was the signature of a trusted certification

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authority. This would have been obvious because the ordinary person skilled in the art would have been motivated to ensure that the public key in the certificate was the public key of the remote party in order to protect against substitution man-in-the-middle attacks.

### *Conclusion*

26. Claims 1-20 have been rejected.

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Richard et al. (US Patent Number 5,922,074) disclosed a system for establishing a secure connection between two remote systems in which a certificate is only verified depending on a database that determines if the certificate owner is trusted or not.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T Henning whose telephone number is (571) 272-3790.

The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew Henning  
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Art Unit 2131  
3/4/2005



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